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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,907	02/20/2002	Ulrich Muller	219667US	2391

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EXAMINER

SAMPLE, DAVID R

ART UNIT PAPER NUMBER

1755

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/049,907

Applicant(s)

MULLER ET AL.

Examiner

David Sample

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-9 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,5,9 and 12 is/are allowed.
- 6) ☒ Claim(s) 6-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/17/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Any rejections/objections made in the previous Office action, and not repeated below are hereby withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Claim Rejections - 35 USC § 102*

Claims 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hasenzahl et al. (EP 893 158).

The one-year grace period of § 102(b) is measured from the U.S. filing date. MPEP 2133. The U.S. filing date of an application filed under § 371 is the PCT filing date. MPEP 506. Therefore, the § 102(b) date of the instant application is August 8, 2000, and Hasenzahl et al. (EP 893 158) qualifies as prior art under 35 U.S.C. § 102(b).

Hasenzahl et al., EP 893 158, is in German. Therefore, the column and line numbers of the English language equivalent US 6,106,803 will be cited below.

Hasenzahl et al. discloses forming a titanium silicalite-1 (a material with the MFI structure) by spray drying a crystallized reaction mixture. See the abstract. Hasenzahl et al. fails to disclose the subsequent treatment of the spray drying carrier gas to condense out the template (instant claim 1 recitation).

However, claims 6 and 7 describe a crystalline solid that is "preparable" by the process of claim 1. As noted above, the process of Hasenzahl is identical to the presently claimed process with the exception of the "downstream" treatment of the carrier gas (which renders claim 1

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patentable). This "downstream" treatment would have no effect on the resultant crystalline solid. Therefore, the product of Hasenzahl appears to be identical to the presently claimed product and is assumed to be "preparable" by the process of claim 1. Cf. MPEP 2113 (which states that product by process claims are not limited to the manipulations of the recited steps for patentability, only the structure implied by the steps).

As to claim 8, Hasenzahl et al. describes a titanium silicalite-1 product (an MFI structure) that is "preparable" by the process of claim 1. Moreover, Hasenzahl et al. discloses employing such a product in the epoxidation of olefins in the presence of hydrogen peroxide. See col. 6, lines 16-24 and Example 12. Therefore, Hasenzahl et al. is deemed to anticipate claim 8.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive. Applicants argue that since claim 1 (containing the recitations of former claim 4) is allowable, all of the remaining claims are allowable. For the reasons stated above, this argument is not deemed persuasive. Claims 6-8 are not limited to the manipulation of the steps recited in claim 1 for patentability, only the structure implied by the steps. Moreover, no difference can be discerned between the product of the reference and the presently claimed product.

### ***Allowable Subject Matter***

Claims 1, 2, 5, 9 and 12 are allowed.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

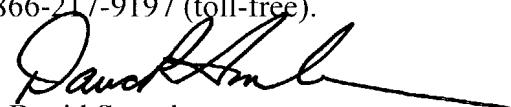
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Sample whose telephone number is (571)272-1376. The examiner can normally be reached on Monday to Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (571)272-1368. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "David Sample", with a long horizontal line extending to the right.

David Sample  
Primary Examiner  
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